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OFFICE OF PETITIONS

|                            |   |                            |
|----------------------------|---|----------------------------|
| In re Application of       | : |                            |
| Liebeschuetz et al.        | : |                            |
| Application No. 10/030,189 | : | DECISION ON APPLICATION    |
| Filed: February 4, 2002    | : | FOR PATENT TERM ADJUSTMENT |
| Patent No. 6,878,725       | : |                            |
| Issued: April 12, 2005     | : |                            |
| Attorney Docket Number:    | : |                            |
| X14660                     | : |                            |

This is a decision on the "Petition for Reconsideration of Patent Term Adjustment After Payment of Issue Fee (37 CFR § 1.705(d)), filed June 2, 2005.

The application for patent term adjustment is DISMISSED.

Patentee is given two (2) months to respond to this decision. No extensions of time will be granted under 37 C.F.R. § 1.136(a).

On April 12, 2005, the above-identified application matured into U.S. Patent No. 6,878,725. The patent issued with a PTA of zero (0) days.

The Office determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of one hundred seventy-nine (179) days pursuant to 37 C.F.R. § 1.702(a)(4), reduced by Applicant's delay of three hundred forty-eight (348) days pursuant to 37 C.F.R. § 1.704(b).

Patentee asserts entitlement to a PTA of two hundred twenty-eight (228) days. Patentee does not address the submission of an Information Disclosure Statement on June 23, 2003, which accounted for an adjustment of sixty-seven (67) days. Patentee states that he timely responded to the non-final Office action mailed July 1, 2003, on October 1, 2003, not December 24, 2003, which accounted for an adjustment of eighty-four (84) days, as reflected in PAIR. Patentee also asserts that the Supplemental response filed March 10, 2004, which accounted for an adjustment of seventy-seven days (77), was necessitated by Office error.

With respect to these 2 reductions, patentee's argument is untimely raised, as this argument should have been made with an application for patent term adjustment pursuant to 37 C.F.R. § 1.705(b), submitted after the mailing of the Notice of Allowance and prior to payment of the issue fee. As stated in 37 C.F.R. § 1.705(d), any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

As to other arguments raised, patentee's arguments are timely and will be considered on the merits. On April 12, 2005, the above-identified application matured into U.S. Patent No. 6,878,725. The instant request for reconsideration, filed June 2, 2005, was timely filed within 2 months of the date the patent issued. See § 1.705(d).

Herein, patentee requests entry of a period of adjustment of 237 days on the basis that the projected issue date of the patent is four months and 237 days after the date of payment of the issue fee. In addition, patentee states that the reduction of 120 days from this patent after applicant's payment of the issue fee is erroneous.

The Patent issued with a revised Patent Term Adjustment of zero (0) days. The PTA of 228 days due to Applicant's delay as indicated in the notice of allowance and as iterated *supra*, was further reduced by 120 days pursuant to 37 CFR § 1.704(c)(10) for the submission of an Amendment after the mailing of the notice of allowance.

Regarding the reduction of 120 days, the entry has been reviewed and found to be correct. Patentee acknowledges submitting a "letter", asking this Office to check that certified copies of the priority documents had been received, after the mailing of

the notice of allowance. Patentee is advised that the filing of a letter after the mailing of a notice of allowance is properly a basis for reduction of patent term adjustment.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

By Notice entitled *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001), the Director set forth examples of papers deemed not to cause substantial interference and delay in the patent issue process. The OG Notice states that:

... the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a

patent term adjustment pursuant to 37 CFR  
1.704(c)(10).

A Comment on the Statement of Reasons for Allowance was so identified; however, here, while Applicant entitled the letter "Comments on Notice of Allowability - Acknowledgment of Claim to Foreign Priority and of Receipt of Foreign Priority Documents", the letter, as admitted by Applicant, was "a letter asking the PTO to check that certified copies of the priority documents had been received". Petition at p.6. Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office. Filing of any papers after allowance, other than those identified in the Notice, will be treated as a failure to engage in reasonable efforts to conclude prosecution.

The period of reduction for Applicant's delay has been correctly calculated at three hundred forty-eight (348) days.

Finally, the application for patent was filed on February 4, 2002, and issued April 12, 2005, three years and 67 days later. However, the Office will not accord an additional period of adjustment for Office delay in issuing the patent. If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004). In this instance, the period of delay totaling 179 days attributable to grounds specified in § 1.702(a)(4) overlaps with the 67 days attributable to the delay in the issuance of the patent. Thus, the period of adjustment cannot exceed the actual number of days of delay of 179 days.

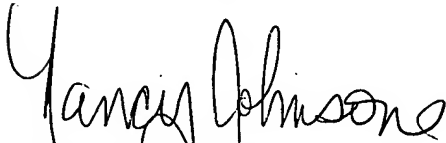
In view thereof, it is concluded that the patent properly issued with a revised Patent Term Adjustment of zero (0) days (179 days of Office delay reduced by 348 days of applicant delay).

Receipt is acknowledged of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The address on the petition is different from the address of record. If Petitioner desires to receive further correspondence with respect to this application, a change of correspondence address must be filed. A courtesy copy of this Decision is being forwarded to Petitioner at the address appearing on the petition; however, all future correspondence will be sent to address of record until instructions to the contrary are received.

The application file is being returned to Files Repository for storage as a patented case.

Telephone inquiries specific to this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.



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